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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/664,634 | 09/19/2003 | William B. Arden II | ARD-101US | 5073 |

24314 7590 08/23/2006

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| EXAMINER |
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HOGE, GARY CHAPMAN

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| ART UNIT | PAPER NUMBER |
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3611

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/664,634 | Applicant(s) ARDERN, WILLIAM B. | |
| | Examiner Gary C. Hoge | Art Unit 3611 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. It has come to the Examiner's attention that in making the previous Office action, the Examiner inadvertently overlooked Applicant's declaration under 37 CFR § 1.131. That declaration has now been considered, and it is deemed effective to antedate the reference to Manley (D479,146). Therefore, the finality of the previous Office action is hereby withdrawn, and a new Office action is set forth below.

Claim Objections

2. Claim 33 is objected to because of the following informalities: on line 2, it appears that "polyethylene" has been misspelled. Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. NOTE: There are two sets of rejections in this Office action, both based on Yochim (1,232,747). The first set treats the transparent cover 11 as the tri-panel binder clip sleeve. The second set treats the label underneath the cover as the tri-panel binder clip sleeve.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6, 14, 15, 17, 18 and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yochim (1,232,747) in view of Sato (5,806,147).

See Fig. 1. Yochim discloses a tri-panel binder clip sleeve, the binder clip comprising first 3 and second 4 resilient jaw portions, a connecting spine portion 6 therebetween and an outer surface along each of the jaw and spine portions, the tri-panel binder clip sleeve comprising

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a first panel 11 in overlying relationship with the first jaw portion outer surface 3, the first panel having an outwardly-facing surface, a second panel 11 in overlying relationship with the second jaw portion outer surface 4, and a third panel 12 spaced between and connecting the first and second panels, the third panel being in overlying relationship with the spine portion and having an outwardly-facing surface. The first and second panels are secured to the respective jaw portion such that the tri-panel binder clip sleeve is held in place on the binder clip. The recitation that the outwardly-facing surfaces are “for displaying indicia located thereon” is merely a statement of intended use. However, Yochim does not disclose a handle secured to each of the jaw portions such that pressing together of the handles separates the jaw portions. Sato teaches that it was known in the art to attach a handle to the jaw portions of a tri-panel clip. It would have been obvious to one having ordinary skill in the art at the time the invention was made to attach handles to the jaw portions of the tri-panel clip disclosed by Yochim, as taught by Sato, in order to open the clip more easily.

Regarding claims 6 and 18, Yochim discloses the invention substantially as claimed, as set forth above. However, it is not known what material is contemplated for the fabrication of the transparent shield. Because it is within the level of ordinary skill of a worker in the art to select from among known materials on the basis of their suitability for the fabrication of a given device, and since a person having ordinary skill in the art would know that plastic would be suitable for the fabrication of a transparent shield, it would have been obvious to one having ordinary skill in the art at the time the invention was made to fabricate the transparent shield disclosed by Yochim from plastic as a matter of choice in design, based on such factors as cost and availability of the materials to the designer.

Regarding claim 20, the bends between the three panels constitute transition portions.

Regarding claim 21, the indicia on element 13 is raised from the clip 6 by virtue of the fact that it is printed on a paper having a thickness.

Regarding claim 23, there is indicia at least indirectly affixed to one of the panels (panel 12) of the binder clip sleeve disclosed by Yochim.

6. Claims 1-12, 14, 15, 17-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yochim (1,232,747) in view of *Smead® Viewables®* and Sato (5,806,147).

See Fig. 1. Yochim discloses a tri-panel binder clip comprising first 3 and second 4 resilient jaw portions, a connecting spine portion 6 therebetween and an outer surface along each of the jaw and spine portions. A transparent sleeve element overlies the jaw portions and the spine. This transparent sleeve element protects a label, but the label is single-sided, rather than three-sided. *Smead® Viewables®* teaches that it was known in the art to provide a three-sided label for a tri-panel clip. It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the single-sided label disclosed by Yochim with a three-sided label, as taught by *Smead® Viewables®*, in order to be able to read label information from the top, front and back. This three-sided label comprises a “tri-panel binder clip sleeve.”

Further, Yochim does not disclose a handle secured to each of the jaw portions such that pressing together of the handles separates the jaw portions. Sato teaches that it was known in the art to attach a handle to the jaw portions of a tri-panel clip. It would have been obvious to one having ordinary skill in the art at the time the invention was made to attach handles to the jaw portions of the tri-panel clip disclosed by Yochim, as taught by Sato, in order to open the clip more easily.

Regarding claims 5, 17 and 30, adhesive comprises an extremely high-frictional engagement.

Regarding claims 6, 18 and 33, Yochim discloses the invention substantially as claimed, as set forth above. However, the label that comprises the tri-panel binder clip sleeve is made of paper. Because it is within the level of ordinary skill of a worker in the art to select from among known materials on the basis of their suitability for the fabrication of a given device, and since a person having ordinary skill in the art would know that polyethylene would be suitable for the fabrication of a label, it would have been obvious to one having ordinary skill in the art at the time the invention was made to fabricate the label disclosed by Yochim, as modified by *Smead® Viewables®*, from polyethylene as a matter of choice in design, based on such factors as cost and availability of the materials to the designer, and because polyethylene labels are more durable than paper labels.

Regarding claim 12, the label disclosed by *Smead® Viewables®* is folded about two lines.

Regarding claim 20, the bends between the three panels constitute transition portions.

Regarding claim 21, the indicia on element 13 is raised from the clip 6 by virtue of the fact that it is printed on a paper having a thickness.

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yochim (1,232,747) in view of *Smead® Viewables®* and Sato (5,806,147), as applied to claim 7, above, and further in view of Bennett et al. (5,522,586).

Yochim, as modified, discloses the invention substantially as claimed, as set forth above. However, although the lable is folded in two places, it apparently does not include a perforation

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to assist in the folding. Bennett teaches (col. 2, lines 56-59) that it was known in the art to provide a perforation to assist in the folding of a sheet. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the label disclosed by Yochim, as modified, with a perforation, as taught by Bennett, in order to assist in folding the label.

Response to Arguments

8. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

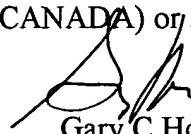
Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Hoge whose telephone number is (571) 272-6645. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gary C Hoge
Primary Examiner
Art Unit 3611

gch